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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,216	10/19/2000	Shigehisa Watanabe	3542-0111P	4485

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

CHIANG, JACK

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691216

Applicant(s)

S. Watanabe

Examiner

T. Ching

Group Art Unit

2642

#10

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 2-24-04
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.**

Disposition of Claims

- ☒ Claim(s) 5, 7 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 5, 7 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

DRAWING

1. The drawings are objected to because Fig. 5 should be labeled as "PRIOR ART".

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

CLAIMS

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Burris et al. (US 4720857).

Regarding claim 7, Burris shows:

A telephone case (110) having an opening (144, channel in 117) formed in a side wall (126, 129);

A sound producing device (140) set in the telephone case (110);

Art Unit: 2642

A casing (142) of the sound producing device (140) has a sound discharging nozzle (141);

The nozzle (141) is inserted in the opening (144, channel in 117) of the telephone case (110).

4. Claims 7 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Konomi (US 4588867).

Regarding claim 7, Konomi shows:

A telephone case (2, 4, 5 in fig. 4, col. 9, lines 33-40) having an opening (for 6-7) formed in a side wall (see front side of 2);

A sound producing device (9) set in the telephone case (fig. 4);

A casing (15) of the sound producing device (9) has a sound discharging nozzle (6);

The nozzle (6) is inserted in the opening of the telephone case (fig. 4).

Regarding claim 5, Konomi shows:

A cylindrical cushion (7 in Konomi).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burris in view of Konomi (US 4588867).

Regarding claim 5, Burris shows:

The telephone case and the sound producing device (fig. 11);

Burris differs from the claimed invention in that it does not have a cylindrical cushion.

However, Konomi teaches providing a sound producing device having a cylindrical cushion (7).

Hence, it would have been obvious for one skilled in the art to modify Burris' sound producing device with a cylindrical cushion as taught by Konomi, this modification would absorb the vibration leaking to the sound producing device, and improve the sound quality of the device (col. 6, lines 9-15).

ARGUMENT

7. In response to the remarks (pages 3-7), on page 4,, applicant argues that Konomi does not show a portable telephone. The examiner likes to provide the following comments. First, the term "telephone" was not used in Konomi. However, the term "two-way voice communication system" has been used in Konomi. It is believed that Konomi's "two-way voice communication system" function as a "telephone".

Applicant further argues that Konomi does not have a case with an opening formed in the side wall. The examiner disagrees. These features are identified in the rejection above, see comments above. In fact, if Konomi does not have a case, how are the electronic components mounted?


Art Unit: 2642

Kobayashi has been withdrawn because it is from the same assignee.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jack Chiang
Primary Examiner
Art Unit 2642